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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,031

12/16/2005

Bernd Gallenkamp

CS8710/BCS033018

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34469

7590

11/18/2008

BAYER CROPSCIENCE LP

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

11/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,031	Applicant(s) GALLENKAMP ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,13-17,20 and 21 is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/2/06&6/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

The Status of Claims :

Claims 11-21 are pending.

Claims 11, 13-17, and 20-21 are allowable.

Claim 12 is rejected.

Claims 18-19 are withdrawn from consideration.

DETAILED ACTION

1. Claims 11-17,20-21 are under consideration in this Office Action.

Priority

2. It is noted that this application is a 371 of PCT/EP04/06607 (06/18/04), which has foreign priority documents, Germany 10329450.3 (07/01/2003) Germany 10331496.2. (07/11/2003).

Drawings

3. None.

Election/Restrictions

Applicant's election with traverse of Group I, namely Claims 11-17,20-21 on 10/23/08 is acknowledged.

Claims 18-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Group II and III, there being no allowable generic or linking claim.

Applicants' argument is as followed:

1. Applicants' traversal is based on the relationship between the method of preparing alkyl esters of 4,4-difluoroacetoacetic acid of formula (I) and the use of such alkyl esters.

With respect to applicants' arguments, Group I and Group II or Group I and Group III lack a special technical feature. Furthermore, In the instant case, the invention of Group I is directed to the method of preparing alkyl esters of 4,4-difluoroacetoacetic acid of formula (I) and the alkyl phosphonate of formula (IV) and the enamine of formula(VI), whereas the invention of Group II is related to the method of preparing the difluoromethyl-substituted pyrazolylcarboxylic acid. The difference between them is the final product ; the final product of the invention of Group I has the non-heterocyclic group ,whereas that of the invention of Group II has the pyrazole group.

Each of them has different modes of operation , different functions or different effects because each of their reactants has a completely different chemical structure with respect to the core structure. For example, the reactant containing a hetero group has been known to have a different reactivity or a different effect in comparison with the one with the non-hetero groups. Therefore, Group I and Group II are unrelated to each other. In addition, each invention has a different use and effect due to unrelated substituents attached to the core of the compounds. Therefore, there is no single general inventive concept and no unity of invention for the method or the process as defined in 37 CFR 1.475.

In the instant case, the invention of Group I is directed to the method of preparing alkyl esters of 4,4-difluoroacetoacetic acid of formula (I) and the alkyl phosphonate of formula (IV) and the enamine of formula(VI), whereas the invention of Group III is related to the method of preparing the difluoromethyl-substituted thiazolycarboxylic acid. The difference between them is the final product ; the final product of the invention of Group I has the non-heterocyclic group ,whereas that of the invention of Group II has the thiazole group.

Each of them has different modes of operation , different functions or different effects because each of their reactants has a completely different chemical structure with respect to the core structure. For example, the reactant containing a hetero group has been known to have a different reactivity or a different effect in comparison with the one with the non-hetero groups. Therefore, Group I and Group II are unrelated to each other. In addition, each invention has a different use and effect due to unrelated substituents attached to the core of the compounds. Therefore, there is no single general inventive concept and no unity of invention for the method or the process as defined in 37 CFR 1.475.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

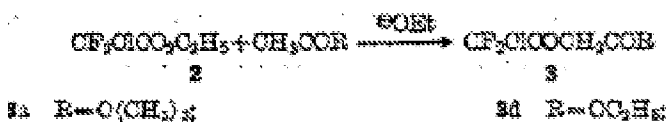
A person shall be entitled to a patent unless –

Art Unit: 1625

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated clearly by Huang et al (Huaxue Xuebao, 1983, 41(8), 723-9).

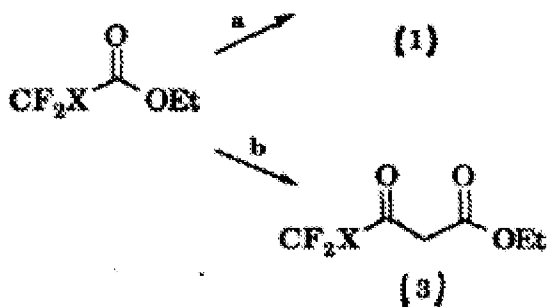
Huang et al discloses the following reaction (see page 723) :



This is identical with the claim.

2. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated clearly by Kitazume et al (J. of fluorine chemistry, 56 (1992), p.271-284).

Kitazume et al discloses the following reaction (see page 278) :



X = H or Cl

(a) RMgX, Et₂O, -78 °C; (b) CH₃CO₂Et, Pr₂NLi, Et₂O

This is identical with the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taylor Victor Oh, MSD,LAC
Primary Examiner
Art Unit: 1625

/Taylor Victor Oh/

Primary Examiner, Art Unit 1625

11/17/08

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